UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,534	05/02/2001	Peter Van Horne	CISCO-4667	6599

7590 01/02/2009

David B. Ritchie
THELEN, REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640

EXAMINER	
WORJLOH, JALATEE	

ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
01/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/848,534
Filing Date: May 02, 2001
Appellant(s): VAN HORNE ET AL.

Khaled Shami Reg. No. 38,745
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 September 2007 appealing from the Office action mailed 23 April 2007.

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,661,517	**BUDOW**	**8-1997**
5,565,908	**AHMAD**	**10-1996**
5,612,730	**LEWIS**	**03-1997**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Applicant's arguments, with respect to 39-54 have been fully considered and are persuasive. The 35 U.S.C. 112, second paragraph of claims 39-54 has been withdrawn.

Claims 58-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 58, 65, and 74 are directed to structure. However, claimed features of the structure are recited using method or process steps (e.g. "said client system…", "client software configured to…"). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.,* 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548).

Claims 59-64, 66-73, 75 and 76 are also rejected as each depends from either claim 58, 65, and 74.

Claim Rejections - 35 USC § 103

Claims 39-57 and 65-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Lewis, U.S. Patent No. 5,612,730.

As per claims 39, 43-47, 50-52, 55, 65, 66, 69-71, 77, 78, 80, and 81, Budow teach client-server communication system comprising:

- specifying a billing preference chosen from a set of billing options that include at least one technique for making a monetary payment (figures 7A-8C)
- transmitting said billing preference to the server system (figures 7A-8C; column/line 12/7-13/10; column/line 24/52-25/28; column 28, lines 30-54)
- receiving a reject or temporary approve signal (or inquiry) from the server system (figures 7A-8C; column 25, lines 28-31, 45-52 and 63-67; column 26, lines 10-13; column 27, lines 10-36)

- a database for storing data, following disconnection of the client system, that identifies each client system, billing information representing an amount of monetary charges accumulated (e.g. data that represents connect time) by said client system (column 7, lines 6-15; column 13, lines 10-13 and 47-49)
- transmitting a rejection from the server system to the client (figures 7A-8B)
- sending periodic connect signals to the server to confirm a connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51)

Budow et al. teach a system for providing interactive and information services to users staying at a hotel (column 13, lines 50-53; column 17, lines 20-35) via a server (column/line 8/62-9/50; column 10, lines 8-25; column/line 11/65-12/6; column 17, lines 20-35) that manages a plurality of user terminals (column 9, lines 38-50; column 11, lines 33-46). However, Budow et al. do not specifically recite the internet. Lewis teaches a system for providing information services such as access to the internet (e.g. two-way communication between a client and an electronic communication network) to users staying at a hotel (column 5, lines 15-21; column 6, lines 14-23; column 7, lines 10-36; column 8, lines 36-50). Therefore, it would have been obvious to one

of ordinary skill to combine the teachings of Budow et al. and Lewis in order to generate additional revenue streams for providing access to the internet.

As per claims 54 and 73, Budow et al. teach receiving a periodic connect signal (i.e. polling response signal to determine if a user is watching a pay-per-view event), providing a clock signal (e.g. polling every two seconds, free preview of event for a limited time such as the first 5 minutes, duration of event, system computer's internal timing mechanism), determining if said periodic signal (i.e. polling signal) is received from the client system within a pre-determined time
period based on said clock signal (i.e. after the allotted time for free viewing) and setting a disconnect parameter (i.e. not processing a bill) if it is determined that said periodic signal (i.e. polling response from client) has not been received from
the client within said predetermined period- "no data" or "data" signal is received during the free period (i.e. not received within said predetermined
period) (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51).

As per claims 40-42, 48, 49, 67, and 68,"software" is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises

a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is inherent that the Budow et al. terminal (figures 4 and 4A) and system includes software. Further, "pushing" data and "updating" software are old and well-known. Therefore, it would have been obvious to

one of ordinary skill to "push" updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

As per claims 53 and 72, Budow et al. teach maintaining a customer portfolio (column 13, lines 10-13) in order to settle a user's bill

which includes client identification information (column/line 28/64-29/3). When using a card to settle the bill a hotel processes the checkout by

transmitting account billing corresponding to the total amount of monetary charges to the customer's credit card company (i.e. network management system) in order to complete the transaction.

As per claims 55-57, 74-76, 79 and 82, Budow et al. teach providing a set of billing options to a user, receiving a billing preference and sending an approval inquiry to a remote approval system (column/line 26/43-27/58). Budow et al. also teach conducting two-way communications over an electronic network (figure 1

and 7A-8B) and a server receiving a rejection signal from a remote approval system and transmitting a rejection signal from the server to the client (figures 7A-8B; column/line 26/43-27/58). Regarding temporary approval signals, Budow et al. allow users to preview pay-per-view selections (column 11, lines 46-65) therefore, the Budow et al. system sends a "temporary approval signal" to the client system prior to the server system receiving the results from the remote approval system. If the user receives an "insufficient funds" message then, it would have been obvious for a user to no longer seek the ability to view the pay-
preview event, and thus discontinuing two-way communications (figures 7A-8B) between client and server (i.e. server discontinues communications with client).
On the other hand, Budow et al. allows for a user to use another card (i.e. additional billing information) if the initial card lacks sufficient funds (claims 57 and 76) (column/line 26/61-27/8).

Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Ahmad, U.S. Patent No. 5,565,908 and Lewis, U.S. Patent No. 5,612,730.

As per claims 58 and 62-64, Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60) and said terminal sends periodic connect signals to the server to confirm a

connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51) and receives temporary approval signals (figures 7A-8B; column 11, lines 46-65). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). Budow et al. do not teach explicitly recite volatile RAM. The RAM of Budow et al. is non-volatile and reserved exclusively for billing. Ahmad teaches a client system comprising a terminal and TV wherein the terminal comprises volatile RAM associated with a processor (column 6, lines 58-67). However, neither Budow et al. nor Ahmad explicitly recite connecting to the internet. Lewis et al. explicitly recite connecting a user to an electronic communications network such as the internet. Therefore, it would have been obvious to one of ordinary skill to modify the terminal of Budow et al. ('517, figures 4 and 4A) by using the processor board of the Ahmad terminal, in order to more efficiently process data by allowing the processor ('517, figures 4 and 4A) to temporarily store data in the RAM ('908, column 6, lines 65-67) and use EPROM to store control programs for the processor ('908, column 6, lines 65-68), and to modify the system of Budow et al. to provide access to the internet for a fee in order to generate additional revenue streams.

As per claims 59-61, Software is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow

et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server

applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is at least obvious that the Budow et al. terminal (figures 4 and 4A) includes software. Further, "pushing" data and "updating" software are old and well-known.

Therefore, it would have been obvious to one of ordinary skill to "push" updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

(10) Response to Argument

112 Rejection-Claims 58-76

Appellant is of the opinion that limitations of claims 58, 65 and 74 of "offer", "receive", "determining", "specify", "transmit", "receive", "accessing" and "conduct" are *functional limitations* (Appeal Brief, page 19, "The MPEP provides as follows…"). However, when these limitations are recited as method steps (e.g. "*offer a user an option… receive* from said user an indication *responsive to said offering*") , the scope of Appellant's claimed apparatus is unclear as claims in hybrid form (i.e. a machine and a process) have been held to be indefinite (A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention- *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990); *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005)).

103 Rejections- 39-82

Appellant is of the opinion that the language of "if a previous session using said client software completed successfully" and "if an approve signal is provided in said receiving" should be given patentable weight. The Examiner respectfully disagrees.

Conditional language inherently comprises at least two conditions: the "if" and the "if not". Appellant's claims, however, are silent regarding how Applicant's system is to perform if the "if not" condition holds. Therefore, for purposes of examination, with regard to these claims, the Examiner has considered the "if not" case. For example, claims 50, 62,and 69 recite performing particular steps "if the client has proper network configuration and registry settings to accomplish communication with the electronic network". However, that is predicated on the client receiving an "approval signal" (see claims 39, 58, 65). As stated above, the Examiner is considering the "if not" case therefore, a rejection signal is received and therefore, claims 50 and 62 do not occur.

The statements "*if* a previous session using said client software completed successfully" and, for example, "*determining that* a previous session using said client software completed successfully" are not logically equivalent, nor do they mete out commiserate scope. One may never happen (i.e. "if"), while the

other presumes that a condition has happened (i.e. client software completed successfully) and details to one of ordinary skill how a system is to perform in response to said condition being detected. The Examiner does not believe that a claim should be limited based on something that may or may not happen. Support for this position can be found in the MPEP (Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation-MPEP 2106 II C) and in CCPA/CAFC decisions (It has been held that *actions that may or may not be done* are indefinite and *does not distinguish the claim from the prior art- In re Collier*, 158 USPQ 266 (CCPA 1968); Because the language of claim 1 refers to "programmable selection means" and states "whereby *when* said alternate addressing mode is selected" the accused device, to be infringing, need only be capable of operating in the page mode. *Contrary to GI/M's argument*, *actual page mode operation in the accused device is not required- Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); As matter of *linguistic precision*, *optional claim elements do not narrow* claim, since they can always be omitted; in present case, elements of dependent claim directed to large diameter spirally formed pipe, which recite "further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased," do not narrow scope of claim compared to

claims lacking those elements, since elements are stated in permissive form "*may*."- *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Therefore, as the combined prior art of Budow and Lewis teach the other limitations of Appellant's claims 39, 43, 46, 50, 58, 62, 65, 67, 77, 78, 80 and 81 that do not depend on "if" statements the prior obviates Appellant's claimed method, system and apparatus.

Claims 58-76

Appellant is of the opinion that the limitations of "offer", "receive", "determining", "specify", "transmit", "receive", "accessing" and "conduct" are *functional limitations* (Appeal Brief, page 19, "The MPEP provides as follows…"). However, claims 58, 65 and 74 are directed to an apparatus. It has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, as the combined prior art teaches a client system comprising a cpu ('517, figures 4 and 4A), volatile memory ('908, column 6, lines 58-67; '517 figures 4 and 4A, column 21, lines 8-21), communications interface coupled to said cpu and memory ('517, column 21, lines 8-21) and (inherently) software (Recall "software" is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third
Edition, page 441, where examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate"-

'517, figures 4 and 4A, column 21, lines 8-21) it sufficiently obviates Appellant's claimed system.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685

Conferees:

Calvin L Hewitt II /CLH/

Supervisory Patent Examiner, Art Unit 3685

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624